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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,504	07/01/2003	Steven C. Shanks	206-038	3500

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EXAMINER

JOHNSON III, HENRY M

ART UNIT PAPER NUMBER

3739

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b> 10/612,504	<b>Applicant(s)</b> SHANKS ET AL.	
	<b>Examiner</b> Henry M. Johnson, III	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10,13-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10,13-30 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Interview Summary</u> .                |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed April 27, 2005 with respect to claims 30 and 32 have been fully considered but they are not persuasive. The cited prior art discloses a mode in which only visible light is generated, the aiming mode.

Applicant's arguments with respect to claims 1-14, 17, 18, 21 and 23-27 have been considered but are not persuasive. Neither the intended use of applicant's device nor the prior art is relevant to apparatus claims. The device of Tatebayashi et al. is capable of having the light sources manually operated when in the unlocked configuration.

### ***Specification***

Full continuation data is required in the first paragraph of the specification. The patent number is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10, 13-14, 17, 18, 21 and 23-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 13 of U.S. Patent No. 6,746,473. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because they are an obvious change in scope. A controller is claimed, yet not claimed in the wand, implying the controller is in another component (base).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9, 10 and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,150,704 to Tatebayashi et al. Tatebayashi et al. discloses a laser therapeutic apparatus with multiple probes, each of which contains a laser diode (Fig. 11, # 46) and optical elements (Fig. 11, # 48). Two optical elements are shown that implicitly can form the laser into various shapes and spot sizes. The probes are disclosed as adjusted by the operator and locked in place (Col. 3, lines 67-68); however, this is intended use of the apparatus. The probes are broadly interpreted as handheld as they may be adjusted by hand and are capable of being moved by hand when not locked. Tatebayashi et al. makes no disclosure that would indicate the probes cannot be operated in an unlocked configuration. A separate control unit is taught for operation of the individual lasers (fig. 1, # 3) and this unit is interpreted as a base. The control discloses the programmable ability to set the irradiation time and density for each of multiple stages (Fig. 21) such programming setting the pulse repetition rate of the individual lasers. The programmability of the lasers yield the capability to radiate continuously or intermittently as desired.

Claims 30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,267,779 to Gerdes. Gerdes discloses an apparatus for therapeutic laser treatment that includes handheld wands (Fig. 7) that each may deliver two wavelengths of laser energy, one in the near infrared range and the other in the visible range (Col. 8, line 54) from solid state diode lasers (Col. 7, lines 22-24). The beams are combined and delivered to the wands which include adjustable optics to focus and shape the beams (Col. 8, lines 31-34). The beam shape may be circular or rectangular (Col. 9, line 49), or a variety of other patterns. A controller for the sources is disclosed that may control the pulse parameters, including, continuous or pulsed, pulse duty cycle and duration of application for each of the radiation sources synchronously or independently with continuous operation possible by selection of a duty cycle of 100 percent (Col. 11, lines 3-8). Specifically mentioned is a pulse frequency of one hertz (Col. 11, line 63). The system is capable of emitting radiation at less than one watt; with 0 to 2.0 W specified for the infrared and 0 to 6 mW specified for the visible (Col. 9, lines 14 and 31). The wavelength disclosed for red is 635 nm (col. 9, line 39), for ultraviolet is 400 nm (Col. 9, line 38) and for infrared is 980 nm (Col. 9, line 27). The handheld wands are connected to the radiation sources within the controller cabinet (base) via optical fibers (Col. 8, lines 23-25). Gerdes discloses a mode in which only the two red aiming beams are generated (Col. 11, lines 45-50), after which, a routine is executed to determine if operation of the therapeutic laser is proper. Clearly, the device is capable of operating with only visible light.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 8, 13-22 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,150,704 to Tatebayashi et al. as applied to claims 1 and 23 above, and further in view of U.S. Patent 6,267,779 to Gerdes. Both are discussed above.

Regarding claim 8, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the laser sources of less than one watt as taught by Gerdes in the invention of Tatebayashi et al. as Tatebayashi et al. is silent regarding power levels, yet it is well known to select low levels for therapeutic treatments as opposed to ablation type treatments.

Regarding claims 13-16 and 26-29, Gerdes discloses the wavelengths cited in the claim. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the wavelengths as taught by Gerdes in the invention of Tatebayashi et al. as they are all known to provide therapeutic treatment.

Regarding claim 17-18, and 20, Gerdes discloses various spot sizes. It is well known in the art to use different spot shapes and sizes for various treatments. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the spot shapes as taught by Gerdes in the invention of Tatebayashi et al. based on the desired therapeutic treatment.

Regarding claim 19, Gerdes discloses a variety of spot shapes for the laser devices, but does not expressly disclose the shape of a plus-sign. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide optics for any shape pattern because Applicant has not disclosed that a specific pattern provides an advantage, is used for a particular purpose, or solves a stated problem. The plus-sign is mentioned only casually in the summary section of the disclosure with no mention of criticality. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any radiation pattern that provided the

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radiation required for treatment because treatment is dependent on the dosage. Therefore, it would have been an obvious matter of design choice to modify the radiation pattern of Gerdes to obtain the invention as specified in claim 19.

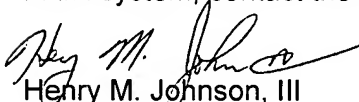
Regarding claim 21 and 22, both Gerdes and Tatebayashi et al. teach optics in each probe that are clearly capable of providing spot shapes unique to the probe or similar to the other probes.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry M. Johnson, III  
Primary Examiner  
Art Unit 3739